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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,406	11/23/2005	Christelle Pragnon	021305-00214	2881

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EXAMINER	
MARTIN, PAUL C	

ART UNIT	PAPER NUMBER
1657	

NOTIFICATION DATE	DELIVERY MODE
12/04/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DCIPDocket@arentfox.com
IPMatters@arentfox.com
Patent_Mail@arentfox.com

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/539,406

Applicant(s)

PRAGNON ET AL.

Examiner

Paul C. Martin

Art Unit

1657

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 November 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

DETAILED ACTION

Claims 1-3 and 5-13 are pending in this application and were examined on their merits.

The objection to the Specification for improperly referencing canceled claims and improper use of trademarks has been withdrawn due to the Applicant's amendments to the Claims filed 11/08/07.

Claim Rejections - 35 USC § 112

Claims 6-13 remain rejected under 35 U.S.C. § 112, 1st paragraph as failing to comply with the written description requirement for reasons of record set forth in the Action mailed 08/08/07.

Claims 10-11 remain rejected under 35 U.S.C. § 112, 2nd paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as their invention for reasons of record set forth in the Actions mailed 08/08/07 and 11/17/06.

Claim Rejections - 35 USC § 103

Claims 1-3 and 5-8 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over Tellam et al. (1986) in view of Menu et al. (2002) for reasons of record set forth in the Actions mailed 08/08/07 and 11/17/06.

Response to Arguments

Applicant's arguments filed 11/08/07 have been fully considered but they are not persuasive.

The Applicant argues that the rejection does not appear to be a new matter rejection as the Arp2/3 complex and Ena/VASP family of proteins are clearly disclosed in the Specification, and that the rejection may actually be based on an alleged lack of written description (Remarks, Pg. 5, Lines 6-17).

This is not found to be persuasive because the rejection was in fact a new matter rejection, based upon lack of written description. Applicant is referred to MPEP 2163.06(I) which states:

If new matter is added to the claims, the examiner should reject the claims under 35 U.S.C. 112, first paragraph - written description requirement. In re Rasmussen, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981).

As stated in the Prior Action, amended Claims 6 and 12 contain the new limitation requiring the addition of subunits selected from the group consisting of the Arp2/3 complex and the Ena/VASP family of proteins and a kit comprising subunits of the Arp2/3 complex and the Ena/VASP family of proteins. Support for this step and kit is not found in the instant disclosure which only teaches the Arp2/3 complex and the Ena/VASP family of proteins in a general fashion, see Specification Paragraphs [0006]-[0008] and [0022], and does not specifically teach the step of addition of either of these compounds in order to activate endogenous actin polymerization or a kit comprising said subunits.

The Applicant argues that by carrying out the methods of analyzing tumor aggressivity of cancerous cells as set forth in claims 1-3 and 5-6, the sensitivity of the cells to an anticancer treatment would necessarily also be determined (Remarks, Pg. 6, Lines 7-14).

This is not found to be persuasive because no where in claims 1-3 and 5-6 is any anti-cancer treatment referred to, and therefore it is unclear how carrying out the methods of those claims to analyze tumor aggressivity will provide any method of evaluating cancer cells to determine their sensitivity to an anti-cancer treatment. This appears to be a goal without any method steps provided to accomplish said goal.

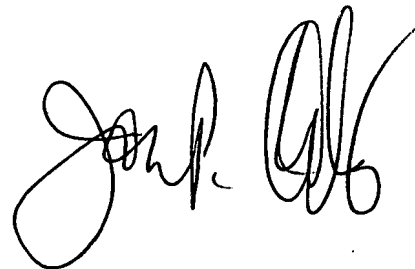
The Applicant argues that Tellam et al. allegedly discloses the use of a large quantity of purified pyrene actin and that therefore their test is not conducted under physiological conditions and that further this test only permits measurement of part of the actin polymerization, and that Menu et al. discloses a completely different method which measures only the F-actin content in the cell at a given time (Remark, Pg 10, Lines 1-24).

This is not found to be persuasive for the following reasons, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the performance of the method under undisclosed "physiological conditions" and performing the measurement "in real time") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The Applicant argues that the combination of Tellam et al. and Menu et al. fails to measure the quantity of actin present in the steady state, as demonstrated by the Amsellem et al. reference (Remarks Pg. 11, Lines 1-11. Furthermore, the Applicant alleges that given the teachings of Tellam et al. and Menu et al. one of ordinary skill in the art would not have known how to measure the polymerized actin at near physiological conditions or how to measure the dynamics of the polymerized actin in real time (Remarks, Pg. 11, Lines 12-18).

At the outset, the submitted exhibit/reference (Amsellem et al.) has been considered however the fact that the actin content of two cell types was found to be the same whereas the Applicant alleges the kinetics of actin polymerization of these cell lysates was completely different is not found to be persuasive because the Applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the performance of the method under undisclosed "physiological conditions", performing the measurement "in real time" or any mention of reaction kinetics in the claims) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

No Claims are allowed.

A handwritten signature in black ink, appearing to read 'Jon Weber', with a stylized, cursive flourish extending from the end.

Jon Weber
Supervisory Patent Examiner